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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

No. 1141

OTTO C. BERRY AND GENERAL MOTORS CORPORATION,

Petitioners,

vs.

BOHN ALUMINUM & BRASS CORPORATION AND ADOLPH L. NELSON.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

JOHN H. BRUNINGA,
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ALEXANDER F. BAILLIO,
Counsel for Petitioners.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

To the Honorable The Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

Your petitioners, Otto C. Berry and General Motors Corporation, respectfully pray for a Writ of Certiorari to the Circuit Court of Appeals for the Sixth Circuit, to review the judgment of that Court entered on January 13, 1942; Petition for Rehearing denied March 5, 1942.

Summary and Short Statement.

This cause involves a suit for infringement of a United States Patent, No. 1,877,490, for an improvement in Pistons, particularly aluminum pistons for internal combustion or gas engines.[1] The District Court (Judge Tuttle) held the patent valid and infringed as to the claims in issue; but the Court of Appeals, while finding infringement of the patent, if valid, held the patent invalid as to the claims in issue and reversed the decree of the District Court. In so deciding, the Court of Appeals readjudicated, without new evidence, issues of patentability decided by the Patent Office in bitterly contested interferences involving the very claims in issue, and in which petitioners were opposed by respondents and another who were then parties to a piston patent-pooling agreement involving the very piston here involved.

The Inventor is the Real Party in Interest.

Petitioner, Berry, is the inventor of the piston of the patent and is still the owner thereof, while General Motors Corporation (hereafter called General Motors) is licensed under the patent by instruments entitled "License" (R. 2364) and "Additional Supplemental Agreement" (R. 2380),[2] the latter constituting an amendment to the former. While the Court of Appeals (R. 2882) has designated Berry as the "owner of the legal title", and General Motors as "the exclusive licensee", the legal effects of the agreements

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[1] Patents for aluminum pistons for gas engines were before this Court on successive petitions for Writs of Certiorari to the Circuit Court of Appeals for the Sixth Circuit, in *Schriber-Schroth Co. et al.* v. *The Cleveland Trust Co. et al.*, in which the decisions are reported at 305 U. S. 47 and 311 U. S. 211.

[2] There are a series of agreements (R. 2364-2388) but the above really determine the nature and scope of the license rights granted.

are such that the inventor remained not only the owner of the patent but retained effective control thereof.

In addition to providing for the payment of royalties, based on the number of pistons, accountings therefor, and also minimum royalties, the inventor retained "the entire control" of the interferences in which the application was then involved, although General Motors did "assume at its own expense and through its Patent Section, the further expense of said interferences", and later of an interference in the Canadian Patent Office. Suits for infringement could only be instituted by General Motors when there was "substantial infringement", with one half of the recoveries to Berry; but the inventor could intervene, and even himself sue, and in such event retain all recoveries. Any "royalty-free cross licensing agreement" to other automobile companies was precluded.

But the most important control retained by the inventor was that General Motors agreed to grant sublicenses to others at the inventor's request and "on reasonable royalties and conditions"; and the inventor's right to proceed against General Motors was recognized for "violation or non-performance". Two such licenses to piston manufacturers were granted (R. 2814, 2821), at royalty rates as low as 1½ cents per piston, and these were specifically approved by Berry (R. 2819, 2826).

Hence this is not the usual case where an inventor has parted with his beneficial interest in the patent. On the contrary, the inventor is the real party in interest here. It is the inventor who stands to lose by the decision of the Court below as his licensee is not required to pay royalties after the patent is held invalid (R. 2367) and the sublicensees have already surrendered their licenses.

Respondents and Another Co-party to a Patent Pool Unsuccessfully Contested Berry's Rights in Prior Proceedings.

Respondent, Bohn Aluminum and Brass Corp. (hereinafter called Bohn Corp.) is a piston manufacturer, one of the parties to a patent pooling arrangement [3] referred to by this Court in the Pistons Cases, 305 U. S. 49. One aspect of the pooling arrangement was to dominate the market, limit production and fix prices on the "so-called control led type" piston which as defined (R. 4745) is the piston of the Berry patent.

Respondent Nelson is a prolific patentee in the piston art. His patents are assigned to Bohn Corporation. Two such Nelson patent applications were involved in interference proceedings with the application for the Berry patent here in suit. The interferences involved the very claims here in suit, namely, 5, 15, 18 and 35. Claim 5 was in Berry's application as filed—claim 35 was taken from Nelson's application. An application of one Jardine (pooled by the Aluminum Company of America with The Cleveland Trust Company) was also involved in that interference.

Although the Primary Examiner had found those claims allowable, both Nelson and Jardine filed Motions to Dissolve on the ground of unpatentability for the same alleged reason and on the same prior art now assigned by the court below as rendering the Berry patent invalid. The interferences were thereupon referred to an independent "Law Examiner", highly qualified and experienced in mechanics and patent law, who rendered his decisions on March 10,

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[3] This pooling arrangement involved a Declaration of Trust (R. 2680), and a series of cross license agreements, (R. 2664, R. 2732, R. 2745) which are summarized in Appendix I hereof.

1927 (R. 2224, 2268), holding the claims in issue patentable (R. 2231, 42, 45; R. 2271, 3, 5).[4]

Nelson admitted (R. 708) that about Decoration Day 1923, Jardine had told Nelson of somebody having shown Jardine a sketch "similar to the design shown in Nelson's Exhibit No. 86" (R. 711), which is at Record page 2151, and which is an illustration of one of the figures in one of the Nelson applications in the interference. Berry testified in the Interferences (Ex. 399 at page 328) of such disclosure to Jardine the day after Decoration Day and that it was of "my piston". Berry further testified (R. 1422-3) that he tried to sell his "idea" to Aluminum Company in 1923 and to Bohn Corporation in 1926, but as to the latter "they just kidded me along and never made an offer of any kind". Den Uhl of Bohn Corporation admitted (R. 1605-6) that Bohn Corporation knew of the Berry application in 1926 when the interferences were declared, and that Berry came to see Mr. Markey of that company. On April 9, 1927, Berry made the license agreement with General Motors (R. 2364), which agreed to assume the anticipated tremendous expense of the interferences.

On October 12, 1927, there were executed the triple series of licenses, as noted above, involving Bohn Corporation, Cleveland Trust and Aluminum Company.

On January 24, 1928, there was another decision (R. 2282) by the Law Examiner, which shows another attempt by Jardine (Cleveland Trust) to have a claim, which is claim 35 of the patent, held unpatentable over the Ricardo and Napier patents and the Nelson published article; but this was again refused.

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[4] Claims 5 and 18 of the Berry patent were numbered counts 1 and 7 of one interference (R. 2268-9); and claims 15 and 35 of the Berry patent were counts 1 and 39 of another interference (R. 2224, 2227). The Knight and Hartog patents cited by the Court of Appeals, and not discussed by the Examiner, were classed with the Napier patent by Judge Tuttle (R. 2090); they are simply cumulative.

Thereafter the decisions on priority by the Examiner of Interference, on January 29, 1930, were favorable to Berry. Both Nelson and Jardine appealed to the Board of Appeals, but that Tribunal on August 21, 1930, affirmed the Examiner of Interferences.

On September 11, 1930, Cleveland Trust (Jardine) sued Berry in the District Court at Detroit under R. S. 4915 to challenge the judgment of the Patent Office. On September 30, 1930, Nelson (Bohn Corp.) proceeded under R. S. 4911 to challenge the same judgment of the Patent Office in the Court of Customs and Patent Appeals. The latter court affirmed the Patent Office on June 20, 1932, 59 F. (2) 351.

While Berry prevailed on the Commissioner to grant his patent on September 13, 1932, the 4915 suit constituted a "cloud on the title" of Berry until decided in his favor by the District Court on August 4, 1934, and affirmed by the Court of Appeals October 12, 1938.

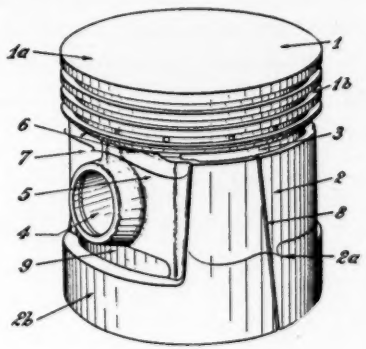
Throughout this series of proceedings, patentability of the claims here in suit was repeatedly attacked by Respondents and Cleveland Trust. Such attack was made before the Law Examiner (R. 2224, 2268 and 2282); the Examiner of Interferences, (R. 2263); the Board of Appeals, (R. 2265); the District Court in the 4915 suit, (R. 2292); and finally in the Court of Appeals for the Sixth Circuit, which held that claims 15 and 35 (both here in suit) "describe an invention common to both Berry and Jardine". (99 F. (2) 517, 522).

The efforts of Respondents and of Cleveland Trust, in the interferences, to not only prevent the issue of a patent to Berry, but to secure its issue to one of them, while they and Aluminum Company were protected by a three-fold tie, (See Appendix I), show the value that was placed on the Berry piston, by the then dominated aluminum piston industry, not only as a solution of the piston problem, but as

a competitor to the flexible pistons of Cleveland Trust and the law expansion aluminum-silicon piston alloys of Aluminum Company, the litigation of which was noted by the Court of Appeals (R. 2885).

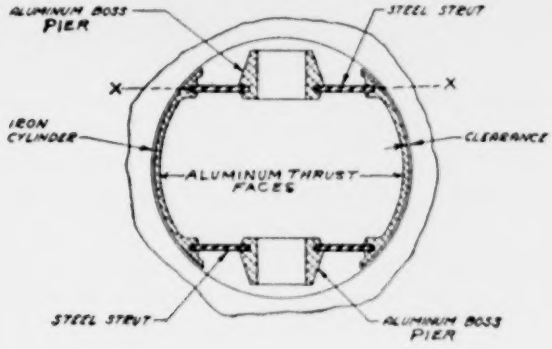
The Berry Patent Piston.

The Berry piston was the result of many efforts to overcome the problem faced by the environment of an aluminum piston in a gas engine, because of the high coefficient of expansion of an aluminum piston compared to that of an iron cylinder. This environment was briefly stated by this Court in the Piston Case, 305 U. S. 49, 51. This court then discussed the various ways suggested and practiced from 1912 to 1922 to compensate for that expansion, including separation of the head from the skirt, vertical splitting of the piston skirt, and making the webs of aluminum flexible. The Court of Appeals also discussed this, 92 F. (2) 330, and here (R. 2885). Low expansion aluminum silicon alloy pistons are discussed in Aluminum Company v. Thompson Products, 122 F. (2) 796. For convenience and comparison, a cut of the accused piston in the Piston Case is inserted here.



However, as will be readily seen, making the aluminum webs flexible made them subject to metal fatigue and breakage, particularly in high speed engines, while that is not true of steel struts (R. 75).

Berry, who was a professor of automotive engineering at Purdue University, solved the problem, but in such a manner, as he stated in the first sentence of his patent, that his "internal combustion engine piston" retained "all the advantages of non-ferrous pistons", but was "free from the disadvantages" thereof. This Berry did in a very simple way. Instead of relying on the flexure of the aluminum webs to compensate for the excess expansion, Berry provided a pair of steel webs cast-embedded at their ends in the ends of the thrust faces, and also cast-embedded at their middles in the piers carrying the bosses. With such a structure, these webs now suppressed the expansion, chordally, in accordance with the low coefficient of expansion of the steel employed in contrast with the high coefficient of expansion of aluminum. This is illustrated by the cut below, which is a cross section of a Berry piston. However, the spacing and anchoring of the struts was such as to produce a strong piston which could be readily cast and later machined to secure any desired thrust face; in other words, it retained "all the advantages of" aluminum pistons as then produced, which was then ground either round or



cam ground oval. This was not only a solution, but indeed an ideal solution, as is evidenced by the fact that Respondents have made and sold over thirty-five million pistons embodying the principle of the Berry patent. How many such pistons were produced by the licensees under the triple agreements we do not know, but the penalties imposed on excess production (twenty cents per piston) and on price deviation (thirty-five cents per piston) are noted in Appendix I.

There was no such piston in the art prior to Berry. Of the prior art cited by the Court of Appeals, the Ricardo piston was an all aluminum piston, which the Court of Appeals found did not solve the problem, even to the extent of the flexible web piston; *Cleveland Trust* v. *Schriber-Schroth*, 92 F. (2) 330. The Knight, Napier and Hartog pistons employed iron rings at or near the bottom, and not at the top where, as Judge Tuttle found (R. 2090), "it is most necessary to control expansion"; the latter was also found by the Court of Appeals in the previous case (92 F. (2) 334). The old Nelson pistons employed a single strut placed at the center, or as duplicate struts close together at the center, which, as found by Judge Tuttle (R. 2090), were "in the wrong place for proper functioning and the piston was difficult to cast". The Law Examiner discussed all this prior art in his decisions (R. 2224, 2268 and 2282), except the Knight and Hartog patents, which are merely cumulative to the Napier patent and classed together by Judge Tuttle (R. 2090).

The Proceedings in the District Court.

The trial was in open court before Judge Tuttle, who has tried many patent cases, who is highly skilled in mechanics, and has a thorough understanding of the principles of patent law. The trial lasted twenty-six days, with frequent examination of witnesses by the court, as well as wit-

nessing of demonstrations. Petitioners' witnesses were Stellmann, whose experience (R. 28 etc.) with automobile and airplane pistons extended from 1909 to date, first, as mechanic, later, chief engineer of Franklin, and now as senior engineer at the Naval Aircraft Engine Factory; Professor Lay, (R. 983 etc.) senior member of the staff, teaching automotive engineering at the University of Michigan; and Townhill (R. 1432 etc.), an engineer highly qualified on the molding and finishing of aluminum pistons. Respondents relied mainly on Ray, a professional patent "expert" (R. 365 etc.), for Nelson testified on the question of priority, which was abandoned at the hearing (R. 2081), and on his single and disc strut pistons.

Excerpts from the oral argument are included in the record at pages 2080-2084; the Opinion of Judge Tuttle at pages 2100-2119; his Findings of Fact and Conclusions of Law at pages 2085-2099; and the Interlocutory Decree at pages 2120-2121. The Berry patent was sustained as to claims 5, 15, 18 and 35 and held infringed by each of the three pistons, Exs. 302, 303 and 304, the first two of which were ground round, while the third was cam-ground oval.

The Decision of the Court of Appeals.

While the Court of Appeals recognized that (R. 2883) Respondents had made thirty-five million pistons[5] which would infringe the Berry patent if valid, no effect in strengthening the presumption raised by the grant was given to this copying by respondents, nor to the large commercial use of the copy, nor to the fact that there was a pressing problem facing the piston art (R. 2883).

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[5] In the language of the Court of Appeals these pistons differed from the Berry patent by "a distinction without a difference", "an immaterial difference", "the accused struts perform the equivalent function of the struts of Berry". (R. 2884).

While the Court of Appeals (R. 2883) mentioned the "interference proceedings between Nelson, Berry and Jardine", and that "priority" was adjudged to Berry, the court said that "these holdings • • • are not controlling when the validity of the claims is involved in an infringement case", citing this Court's decision in the *Piston* case, 305 U. S. 47, 59.

Claim 35 was held invalid (R. 2885), because it does not specify "that the chordal struts which connect the skirt segments shall have a coefficient of expansion less than that of aluminum". In doing so the Court of Appeals did not read or interpret the claim of the patent in the light of its specification, which states specifically that the struts have a lower coefficient of expansion than aluminum; this was recognized by the Court of Appeals (R. 2884).

In considering the proceedings in the District Court, the Court of Appeals assumed (R. 2886-8) that the District Court had found and concluded that cam grinding the skirt of the Berry piston oval was "an essential element" of the patented structure, and that the District Court had "read into the claims in issue as an essential element" such cam grinding. That this could not be so is apparent from the Court of Appeals reference (R. 2888) to the "Packard narrow-strut piston, which is not ground oval", and which had been referred to (R. 2883), as one of the accused pistons, and as to which the Court of Appeals stated (R. 2885) "We conclude that the District Court correctly found that the accused pistons infringe if the Berry patent is valid".

The Court of Appeals then (R. 2888-91) considered the Berry patent structure and, after discussing the prior art, concluded (R. 2890) "the only substantial distinction between Berry and Ricardo lies in the substitution of metals which was old". The question of substitution of metals

had, however, been passed upon, favorable to Berry, by the Patent Office Tribunals in the interference proceedings; and there was no new evidence before the Court of Appeals, for although the Knight and Hartog patents were not mentioned by the Examiner, they are simply cumulative to the Napier patent before the Examiner, and they were so classed together in the District Court's finding (R. 2090).

Reasons Relied Upon for the Allowance of the Writ.

Petitioners believe that the Writ of Certiorari should be granted in these cases for the following reasons:

I.

The Circuit Court of Appeals for the Sixth Circuit has held unpatentable, over prior art, claims of a patent owned by the inventor Berry, the application for which patent was involved in bitterly contested interference proceedings with applications of respondents and another party. Respondents and the other party not only contested patentability of those very claims throughout those interference proceedings, over substantially the same prior art and with substantially the same evidence, but after failing, contested priority before the Tribunals of the Patent Office, the Court of Customs & Patent Appeals, the District Court of the United States and the Circuit Court of Appeals. Meanwhile respondents and the other party to the interference proceeded with, and were operating under, piston patent-pooling agreements dominating the aluminum piston industry, including the applications of respondents and such other party and covering this very piston; and meanwhile respondents proceeded with the manufacture and sale of this very piston and sold them in tens of millions.

The decision of the Court of Appeals raises the important question whether an inter partes determination of

patentability, contested in an interference proceeding, is impressed with any finality as between the same parties and upon the same claims, in the absence of any newly discovered non-cumulative evidence, or whether the question remains open for future litigation between the same parties.

The question involves the application of this Court's decision in *Radio Corp.* v. *Radio Lab.*, 293 U. S. 1, 2 and 8, where a question of patentability of claims over prior art was involved; and whether such decision is limited by this Court's decision in *Schriber-Schroth* v. *Cleveland Trust*, 305 U. S. 47, 59, which involved a question of sufficiency of description in the specifications, and was not between the same parties as in the interference.

II.

The Circuit Court of Appeals misconceived the findings and conclusions of the District Court, by erroneously assuming that the District Court found and concluded that cam grinding oval the skirt of the Berry patent piston was an essential feature of the patented structure, and that the District Court read into the claims of the patent such feature as an essential element; whereas, the District Court in fact found the patented structure as one which advantageously permitted cam grinding as practiced in the making of pistons before Berry, and whereas the District Court found and concluded infringement of the claims by two accused pistons in which the skirts were ground round and not oval.

The decision of the Court of Appeals raises the important question whether the decision of this Court in *Schriber-Schroth* v. *Cleveland Trust*, 305 U. S. 47, denies to an inventor of a patented structure the potencies, capacities, advantages, uses and practices of the prior art, which the patented structure is capable of and adapted for, and

whether the decisions of this Court in *Radio Corp.* v. *Radio Lab.*, 293 U. S. 1, 11, 12 and 14; *Webster Loom Company* v. *Higgins*, 105 U. S. 580, 586, approved in *Honolulu Corp.* v. *Halliburton*, 306 U. S. 550, 559; are limited by the decision of this Court in *Schriber-Schroth* v. *Cleveland Trust*, supra.

III.

The Court of Appeals held claim 35 of the Berry patent invalid, because it does not "specify that the chordal struts which connects the skirt segments shall have a coefficient of expansion less than that of aluminum", although the specifications do so specifically state, and although there was no file wrapper history restriction in this respect.

This is clearly contrary to this Court's decision in *Schriber-Schroth* v. *Cleveland Trust*, 311 U. S. 211, 217, that "the claims of a patent are always to be read or interpreted in the light of its specifications", if there is no file wrapper history in this respect.

IV.

The Court of Appeals held the claims in issue of the Berry patent invalid, as involving simply a substitution of materials, although the claims are for new combinations of which steel struts are elements, but combined in a new way with the remaining elements of a piston, namely; the aluminum thrust faces and the aluminum piers extending down from the aluminum head to form an integral structure. The Court of Appeals refused to give effect to the decisions of the Tribunals of the Patent Office in the interferences where this question was litigated on substantially the same evidence by Berry and respondents. The Court of Appeals refused to give effect to the factors of long felt want; of a problem in this art solved by the inventor Berry; copying by and the great commercial success of the patented piston by respondents; of the great enrich-

ment by respondents and its colleague (another party to the interference) in piston patent pool which sought to and did dominate the market in the Berry piston; and of the bitter contest by respondents and then colleague, seeking to obtain the patent for Berry's invention. The Court of Appeals also refused to accept the findings of the District Court on the novelty of the patented piston, on the failure of the prior art to solve the problem, of unobviousness, and that it involved more than mechanical skill.

The question here involves the application of this Court's decision in *Smith* v. *Goodyear Dental Vulcanite Company*, 193 U. S. 486, 496, that a combination is patentable even if there is substitution of material of one of its elements, where such substitution involves a new mode of construction, or develops new uses and properties of the article formed; particularly where there was a problem solved by the patentee and commercial success (193 U. S. 495).

The decision of this Court has been lately followed by Courts in other Circuits; *United Shoe Machinery Co.* v. *Ferree*, 64 F. (2) 101, 103, C. C. A. 2; *Tyra* v. *Adler*, 85 F. (2) 548, 552, C. C. A. 8, and *Gasoline Products Co.* v. *Coe*, 87 F. (2) 550, 557, App. D. C. All of these cases involved combination claims and are in apparent conflict with the decision of the Court of Appeals in this case. This Court has not reviewed this question since *Magowan* v. *New York Belting Co.*, 141 U. S. 332. Its importance is demonstrated by the facts that in the *United-Ferree* case, supra, this Court granted certiorari, 290 U. S. 614; but the case was dismissed per stipulation of counsel, 290 U. S. 708.

Prayer.

Wherefore, your petitioners respectfully pray that a Writ of Certiorari be issued to the Circuit Court of Appeals for the Sixth Circuit, to the end that this cause may

be reviewed and determined by this Court; that the decree of the Circuit Court of Appeals for the Sixth Circuit be reversed; and that petitioners be granted such other and further relief as may be proper.

OTTO C. BERRY and
GENERAL MOTORS CORPORATION,
By JOHN H. BRUNINGA,
JOHN H. SUTHERLAND,
ALEXANDER F. BAILLIO,
Attorneys for Petitioners.

April 13, 1942.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of Court Below.

The Findings of Fact and Conclusions of Law of the District Court are found at pages 2085-2099 of the Record, Volume III; the opinion of the District Court is found at pages 2100-2119, officially reported in 29 F. Sup. 516; and the Interlocutory Decree of the District Court at pages 2120-2121 of the Record.

The Opinion of the Circuit Court of Appeals (before Circuit Judges Simon, Allen and Hamilton, Judge Allen writing) appears at pages 2882-2891 of the Record and is reported in 124 F. (2d) 865.

Jurisdiction.

The Decree of the Circuit Court of Appeals was entered January 13, 1942, and appears at page 2881; the Petition for Rehearing appears at 2892-2916; and the Order denying the Petition for Rehearing, entered March 5, 1942, appears at page 2917.

Statement of the Case.

The foregoing Petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ as well as a statement of the questions involved in the case.

Specification of Errors.

I.

That the Court of Appeals erred in holding the Berry patent invalid on the same ground upon which respondents had attempted unsuccessfully to persuade the Patent Office

to hold the subject matter unpatentable in the Interference proceedings.

II.

That the Court of Appeals erred in concluding that the District Court had read "oval grinding" into the claims of the patent in suit.

III.

That the Court of Appeals erred in failing to read claim 35 of the Berry patent in the light of its specifications.

IV.

That the Court of Appeals erred in holding that the Berry patent differed from the prior art merely in the substitution of materials.

V.

That the Court of Appeals erred in reversing and not affirming the Decision of the District Court.

ARGUMENT.

I.

The Court of Appeals Permitted Respondents to Relitigate a Question Which Had Been Determined in Favor of Berry in Previous Proceedings, Contrary to this Court's Decision in Radio Corp. v. Radio Lab., 293 U. S. 1.

The purpose for the granting of the patents is, of course, found in the Constitution (Art. 1, Sec. 8), namely, "to promote the progress of science and the useful arts"; and one who does that should naturally be favored by the law and secure the fruits of his invention. As this Court said in *U. S.* v. *Dubilier Corp.*, 289 U. S. 178, 186:

> "An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of

value to the community by adding to the sum of human knowledge."

In *Mumm* v. *Decker & Sons*, 301 U. S. 168, 171, this Court cited with approval a number of early cases dealing with the presumption raised by the grant, and that the burden is upon the defendant to overcome that presumption; this Court said:

> "• • • Not only is the burden to make good this defense upon the party setting it up, but his burden is a heavy one, as it has been held that 'every reasonable doubt should be resolved against him.' Id., Cantrell *v.* Wallick, supra; Coffin *v.* Ogden, 18 Wall. 120, 124; Barbed Wire Patent, 143 U. S. 275, 284, 285; Adamson *v.* Gilliland, 242 U. S. 350, 353."

The presumption raised by the grant is, however, strengthened by the fact that the prior art was before the Examiner, particularly where it has been subjected to the opposition of counsel in interference proceedings; *Hildreth* v. *Mastoras*, 257 U. S. 27, 32:

> "This, as already said, is the claim which was framed in the Patent Office as the issue of the interference proceeding, and of which Dickinson was given priority over all. The presumption of priority and novelty which arises from the granting of a patent must have greatly increased weight when the claim of the inventor is subjected to such close and careful scrutiny under the stimulus of a heated contest."

When a suit for infringement is preceded by an interference proceeding between the same parties on the same subject matter, the presumption of validity is strengthened to conclusiveness. As the court, through Mr. Justice Cardozo, said in *Radio Corp.* v. *Radio Lab.*, 293 U. S. 1:

> "For the purpose of any controversy between Armstrong and DeForest *the validity of* the patents *must be accepted as a datum.*" (l. c. 2)

In that case Armstrong and DeForest had contested an interference and hence were in the position respectively of Nelson and Berry here.

> "The outcome of their contest was—binding on the claimants and their several assignees".

In the interference proceeding between Nelson (Bohn Corp.) and Berry, the Patent Office tribunals considered, on Motions of Nelson and Jardine (R. 2224-2246, 2268-2275, 2282-4) the Ricardo patent, the Nelson single and duplicate middle strut patents and the Napier patent. Yet the Court of Appeals held the Berry patent invalid as involving a mere substitution of materials in Ricardo (R. 2890). Significant is the fact that this very argument was advanced, without success, in attacking patentability in the interference (R. 2231, 2273). The Court of Appeals seemed to attach significance to the fact that Berry frankly admitted having heard Nelson read the paper suggesting the possibility of a steel strut. But the paper was also before the Patent Office and, in answer to Nelson's contention that he "disclosed the invention to Berry by a paper" (R. 2265), the Board of Appeals held:

> "The paper does not disclose the invention in issue."

Respondents have, therefore, had their day in court on the very point upon which the Circuit Court of Appeals based its decision. They failed before. They should not be permitted to reopen the question (at least in the absence of newly discovered non-cumulative evidence).

Regard for the doctrine of finality of judgments would seem to foreclose respondents from attacking validity on the grounds urged in the previous proceeding.

Such was the effect of *Radio Corp.* v. *Radio Lab., supra.* The rule was not altered by *Schriber-Schroth* v. *Cleveland Trust Company,* 305 U. S. 47, because there the question

previously determined in an interference was relitigated by a stranger to the interference proceeding.

II.

The District Court Did Not Read Cam or Oval Grinding into the Claims of the Berry Patent.

There were three accused pistons, namely, Ex. 302, the Packard narrow-strut, Ex. 303, the Dodge Wide Strut, and Ex. 304, the Autothermic. Only the Autotholermic was cam ground oval, while the other two were ground round or circular (R. 94); the Court of Appeals so said as to the narrow-strut piston (R. 2888). The District Court concluded both of these round ground pistons were infringements of the Berry claims in issue (R. 2095-6 and R. 2120), and the Court of Appeals distinctly said as to all of the accused pistons (R. 2885):

> "We conclude that the District Court correctly found that the accused pistons infringe if the Berry patent is valid".

Obviously the Court of Appeals was in error when it held (R. 2888):

> "We conclude that the District Court read into the claims in issue as an essential element the requirement that the thrust surface should be 'cam ground.' This was not revealed in the drawings, the specifications, or the claims, and therefore the patent held to be valid was neither claimed nor granted. Altoon *v.* American Tri-Ergon, 294 U. S. 477, 487; Schriber-Schroth *v.* Cleveland Trust Co., supra; Permutit Co. *v.* Graver Corp., 284 U. S. 52."

It is true Judge Tuttle discussed cam grinding with the witnesses and counsel during the trial, but nowhere did he consider cam or oval grinding an "essential" feature of the Berry patent structure, but at most that this Berry

structure had the potencies, capacities, advantages and capabilities that it could be cam ground; *Radio Corp.* v. *Radio Lab.*, 293 U. S. 1, 12, 14; *Webster Loom Company* v. *Higgins*, 105 U. S. 580; recently approved in *Honolulu* v. *Halliburton*, 306 U. S. 550, 559. It was not even mentioned by Judge Tuttle in his discussion of the claims in his Opinion (R. 2117-8), and not at all in his findings (R. 2095-6). The position of Petitioners' counsel and the understanding of Judge Tuttle are clearly shown by the following colloquy at the trial (R. 1653):

> "The Court: You say I am not concerned with whether or not—I don't know whether they have got a patent now that calls for cam-grinding, or whether that is an improvement of yours, or whether it is old, or what-not, because that cam-grinding business is not in your patent at all.
>
> "Mr. Bruninga: No, it isn't described, but anyone skilled in the art, producing a piston like that, and finding it bearing at the corners, would immediately resort to it. That is the thing. And that is permissible by the art. It don't mean we apply for a patent on that thing for the use of cam-grinding, or a thing like that. We don't claim the patent for that would even be considered by the Patent Office as something patentable. There is nothing in that at all."

The situation is, therefore, one where the Court of Appeals, at the instance of Respondents' counsel, has set up a straw man, which was then knocked down by the doctrine of *Schriber-Schroth* v. *Cleveland Trust*, 305 U. S. 47.

III.

The Court of Appeals' Decision Holding Claim 35 Invalid is Contrary to the Decision of this Court in Schriber-Schroth v. Cleveland Trust, 311 U. S. 211.

The Court of Appeals' Decision is so clearly contrary to the decision of this Court in *Schriber-Schroth* v. *Cleve-*

land Trust, 305 U. S. 47, that it will be only necessary to quote claim 35 of the Berry patent in connection with claim 8 of the Jardine patent there in suit.

Berry claim 35 (R. 2161) reads as follows:

> "35. A piston having a head, piers depending from the head, piston pin bearings formed in the piers, cylinder-bearing portions on opposite sides of the piston, a pair of chordal struts, each of said struts extending between the cylinder-bearing portions, the intermediate portion of each strut being surrounded by the material of a pier, there being an integral connection between each of the cylinder-bearing portions and each pier."

Jardine claim 8, 311 U. S. 211, 218:

> "8. In a piston for an internal combustion engine, the combination of a head having a cylindrical ring flange, oppositely disclosed webs integral with the flange and carrying diametrically opposite piston pin bosses, skirt integral with said webs and cut away to expose the sides of said webs and separated from the ring flange by circumferential slits and provided with a longitudinal slit disposed between the ends of the webs."

This Court said, 311 U. S. 211, 217:

> "The claims of a patent are always to be read or interpreted in the light of its specifications, Hogg *v.* Emerson, 11 How. 587; Carnegie Steel Co. *v.* Cambria Iron Co., 185 U. S. 403; Smith *v.* Snow, 294 U. S. 1; and we may assume that if in the present case the specifications and claims of the patent were to be interpreted without reference to its file wrapper history, the webs referred to in the claims are the webs described in the specifications as capable of bending in cooperation with the slotted piston guides or skirts so as to compensate for thermal expansion and so supply the element of webs laterally flexible which was wanting to Gulick and to Maynard."

It is not necessary to even paraphrase this Court's language to show that the situations in the two cases were identical; except that here there was no file wrapper history restriction in this respect, because there was no substantial amendment to the Berry application as filed and claim 5 of the patent was original claim 8 (R. 2473-80).

IV.

The Berry Patent Piston Does Not Involve Merely a Substitution of Materials, but Involves a New Combination.

This case is not as broad as a mere substitution of materials, as was the Door Knob Case, *Hotchkiss* v. *Greenwood*, 11 Howard 248, involving merely the making of a door knob of clay or porcelain, instead of iron, brass, wood or glass. This case is much narrower, because the Berry patent involves a combination in which the factor of substitution of materials is only one factor; for the steel struts are so positioned and combined with the aluminum thrust faces and aluminum boss piers, as to produce an entirely new piston structure having properties and capabilities not possible with prior art pistons.

This case is on all fours with the Tooth Plate case, *Smith* v. *Goodyear Dental Vulcanite*, 93 U. S. 486, the patented structure of which this Court said, l. c. 492:

> " 'consists in forming the plate to which the teeth, or teeth and gums, are attached, of hard rubber, or vulcanite, so called, an elastic material, possessing and retaining in use sufficient rigidity for the purpose of mastication, and at the same time being pliable enough to yield a little to the motions of the mouth.' "

Of this combination this Court said, l. c. 494:

> "* * * A new product was the result, differing from all that had preceded it, not merely in degree of

> usefulness and excellence, but differing in kind, having new uses and properties."

In distinguishing from the Door Knob Case, which involved the complete substitution of clay or porcelain for iron, brass, or wood, this Court said, l. c. 496-7:

> "It does not decide that no use of one material in lieu of another in the formation of a manufacture can, in any case, amount to invention, or be the subject of a patent. If such a substitution involves a new mode of construction, or develops new uses and properties of the article formed, it may amount to invention.
>
> "* * * But where there is some such new and useful result, where a machine has acquired new functions and useful properties, it may be patentable as an invention, though the only change made in the machine has been supplanting one of its materials by another. This is true of all combinations, whether they be of materials or processes."

While the Tooth Plate case has been applied by this Court in only one subsequent case, involving the question of substitution of materials, *Magowan* v. *New York Belting Co.*, 141 U. S. 332, where the patent was held valid, it has recently been cited and applied in other Circuits in upholding the validity of combination patents, involving this question, as follows: *United Shoe Machinery Co.* v. *Ferree*, 64 F. (2) 101, 103, C. C. A. 2; *Tyra* v. *Adler*, 85 F. (2) 548, 552, C. C. A. 8; *Gasoline Products Co.* v. *Coe*, 87 F. (2) 550, 557, App. D. C.

This Court (93 U. S. 495) considered the factors that there was a problem in the art (as the Court of Appeals found here, R. 2885), and that the patented combination had solved that problem as evidenced by its commercial success (as we have here). That others in the field sought to solve the problem has been considered a factor by this court, in determining whether inventive ingenuity was involved;

Potts v. *Craeger*, 155 U. S. 597, 607; so has the fact that defendant has copied the patented structure even though the art had alternatives; *Diamond* v. *Consolidated*, 220 U. S. 428, 441. These and other factors, previously noted, were not given any weight by the Court of Appeals in this case.

Judge Tuttle's Findings 18, 19 and 20 (R. 2092) were arrived at after hearing, seeing and examining witnesses and witnessing demonstrations for twenty-six days. His finding that the Berry "combination was not obvious to those skilled in the art and required more than mechanical skill", was supported by the highly qualified Stellmann, after consideration and discussion of the entire prior art, not only on direct examination (R. 2045-6), but also on cross examination (R. 2075-6). That was not disputed by any one skilled in this art. This was really a question of fact which is properly a finding; *St. Paul Plow Works* v. *Starling*, 140 U. S. 196-7; particularly where the trial court not only heard and saw the witnesses, but witnessed demonstrations; *United States* v. *United Shoe Machinery Company*, 247 U. S. 32, 38 Sup. Ct., l. c. 476.

The only prior art not discussed by the Patent Office tribunals were the Knight and Hartog patents; the latter was issued to Cleveland Trust, and its application (467,587) was included in the patent pool (R. 2678), as was also (R. 2679) the Napier patent. Judge Tuttle classed them together in his finding (R. 2090) as follows:

> "But this ring was only below the wrist pin boss and not at the top, where it is most necessary to control expansion, and was little more than an iron cylinder with aluminum around it—and a heavy iron cylinder, at that."

This finding is fully supported by the experienced and practical Stellmann, (R. 1855-8) who was examined by Judge Tuttle on such structures. Stellmann cited his ex-

perience with such a piston in the Franklin automobile; Nelson's own patents 1,161,709 (R. 2452, lines 82-99, and R. 2350, lines 99-110), show the impracticability of such a piston having such a necessarily heavy ring. That, of course, includes Hartog, as well as Napier and Knight, all of which are simply cumulative.

It is respectfully submitted that the evidence we have here is no different than before the Primary Examiner and the Law Examiner. The worthless and impractical iron ring devices of the Knight and Hartog pistons are simply cumulative of that of Napier considered by the Law Examiner. Even the Board of Appeals decided (R. 2265) that the Nelson publication did not "disclose the invention in issue" to Berry, who heard that paper, which hearing of the paper the Court of Appeals for some reason considered significant (R. 2889). The Findings of Judge Tuttle are entitled to the full force and effect contemplated by Civil Rule 52 (a), and should not have been set aside.

Conclusion.

As this Court recognized in the Piston Cases, 305 U. S. 47, 49, due to the concentration of the automobile industry in the Sixth Circuit, litigation elsewhere is improbable. Petitioner Berry resides in the same circuit (R. 1416). While we are at war, and while the manufacture of automobiles stopped shortly after the decision of the Court of Appeals, the questions raised in this Petition are still important.

It is important, during even the present period, that the progress of science and the useful arts be promoted, and that inventors be encouraged to use their ingenuity to promote that progress to make inventions. It is, therefore, important that the incentive to reward provided for in the Constitution and enacted in our Patent Statutes be kept burning.

This case is one of the most outstanding instances of the trials and tribulations of an inventor that we can find in the annals of invention. Berry, a professor, with the finances of such a man, made a contribution to an art, which was crying for something to solve the problem encountered. That he did so is evidenced by the tremendous commercial acceptance of his invention. After the usual delays before the Primary Examiner, he succeeded in securing allowance of his claims. But then he was faced with expensive and delaying interferences proceedings, by interlopers whose filing dates were from one to two years subsequent to his, and who, when all is said and done, derived their knowledge from Berry. After these very interlopers would not even deign to "make an offer", he turned to General Motors, who was willing to contract on a basis to give the inventor the complete control of the patent rights, and pay the expenses of the interference proceeding which the inventor did not have a chance to combat alone.

Now after years of exploitation of Berry's invention, while respondents were protected by the umbrella of a pool of patents, most of which were later found to be invalid, and after seeking to bring Berry's invention under that umbrella by their own applications, the respondents say that Berry's invention was obvious to any one skilled in the art. And they so contend, even though when they were trying to cover the Berry piston, they considered its patent worth alone, from twenty cents to thirty-five cents per piston, and they sold thirty-five million of those pistons.

The observation of this Court, years ago in the *Barbed Wire Patent* case, 143 U. S. 275, on another phase of seeking to appropriate inventions, is apropos, when this Court said l. c. 284:

> "* * * The very fact, which courts, as well as the public, have not failed to recognize, that almost every important patent, from the cotton gin of Whitney to

the one under consideration, has been attacked by testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny. Indeed, the frequency with which testimony is tortured, or fabricated outright, to build up the defence of a prior use of the thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer."

Berry is entitled to the benefits of the patent laws based, as they are, on the Constitution. That is all he asks for as a reward for his contribution to this art, and as an incentive to other inventors.

Respectfully,

OTTO C. BERRY and
GENERAL MOTORS CORPORATION,
By JOHN H. BRUNINGA,
JOHN H. SUTHERLAND,
ALEXANDER F. BAILLIO,
Attorneys.

April 13, 1942.

APPENDIX I.

The Triple Agreements.

A Trust Agreement of 1917, with The Cleveland Trust Company as title holder, (R. 2700) was terminated on March 7, 1922, (R. 2726), and superseded by a declaration of trust (R. 2680), dated March 7, 1922. The trustee, Cleveland Trust, was granted the right to sue for infringement (R. 2682), and that (R. 2684):

"2. It shall be the policy of the Trustee in the conduct of the trust to endeavor or induce or require all who use the patented inventions or improvements belonging to this trust to recognize the Letters Patent relating thereto."

There was a provision for distribution of shares of beneficial interest (R. 2686-7) and Bohn Corp. secured such an interest (R. 1586), as did also Nelson (R. 1304). There was also provided a reserve for litigation of $7,000.00 to $25,000.00 (R. 2689).

The Cleveland Trust license to Bohn Corp. (R. 2664) covered "structural" piston patents, as distinguished from patents dependent upon the "material" of the piston or their "processes" of production. There was a limit of permissible production set (R. 2665) with a penalty of ten cents per piston for any excess (R. 2675); however, there was no production limit if Bohn Corp. did not produce the "so-called controlled type" which, as defined, (R. 2665) was the Berry piston. The Aluminum Company license to Bohn Corp. contained like provisions (R. 2733, 2740). The Bohn Corp. license to Aluminum Company was for the production of the "so-called controlled type" piston (R. 2745). Here the royalty was based upon the extent that Aluminum Company restricted itself and its licensees, with no royalties payable up to five million pistons, but with twenty cents per piston on the excess of these "so-called controlled type" (R. 2747-8). Here there was a price fixing provision penalizing Bohn Corp., as well as Aluminum Company, to the extent of thirty-five cents per piston (R. 2757) and Den Uhl of Bohn Corp. admitted that this price

fixing was in effect until 1931 (R. 1607). This license really restricted production to Aluminum Company and Bohn Corp. (R. 2756), who divided the field in the production of this piston.[6]

The triple licenses specifically obligated the licensor to sue for infringement (R. 2666, 2750), or in the alternative that payment of royalties would cease (R. 2741); however, the licensee was given the right to sue in two of the licenses (R. 2667, 2750). Aluminum Company excluded alloys but not heat treatments from its license to Bohn Corp. (R. 2739); but Bohn Corp. purchased its alloys from Aluminum Company and has a license on heat treatment (R. 1596).

The triple licenses were all entered into on the same day, namely, October 12, 1927, and at that time Bohn Corp. was manufacturing and selling the Packard narrow strut piston and had been since May 11, 1926, (Fds. 5, 7, R. 2086). This is one of the pistons which Judge Tuttle simply deemed (R. 2115) "a good job of hitching the struts to the skirt segments" of the Berry piston; while the Court of Appeals simply found (R. 2884) "a distinction without a difference", an "immaterial difference", and that "the accused struts performed the equivalent function of the struts of Berry".

The Aluminum Company patents covered broadly a chill cast aluminum piston and a process and apparatus for casting them in permanent molds; see Aluminum Company vs. Sterling Company, (66 F. (2d) 598, C. C. A. 8); and that was the only practical way to cast them (R. 1464). They were not finally held invalid until July 18, 1933, in the case cited. Other patents of Aluminum Company were alleged to cover broadly the chill casting of aluminum-silicon alloys, with and without other alloying constituents; Aluminum Company vs. Thompson Products Company, 122 F. (2d) 796; and such patents were not finally held invalid until October 9, 1941.

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[6] There was later, January 1, 1929, a very limited license by Bohn Corp. to Aluminum Industries (R. 2762) with a very small maximum production of 500,000 pistons at a royalty of two cents per piston (R. 2766), but with the same penalties for excess production (R. 2763) and violations of price restrictions (R. 2707).

The Cleveland Trust patents constituted an imposing series, and they are included in this record and were before this Court in the Piston Cases, 305 U. S. 47 and 311 U. S. 211. The principal ones were the following: Spillman & Mooers, 1,092,870, expired April 14, 1931, with its broad claims (R. 2190); the Franquist patent 1,153,902, expired September 21, 1932, with its broad claim 7 (R. 2194); the Schmiedeknecht patent 1,256,265 (R. 2397), expired February 12, 1935, held invalid October 6, 1939; the Maynard patent 1,655,968 (R. 2213), expiring January 10, 1945, held invalid October 6, 1939; the Jardine patent 1,763,523 (R. 2206), expiring June 10, 1947, but held invalid December 5, 1940; the Gulick patent (R. 2198) 1,815,733, expiring July 21, 1948, and held invalid on October 6, 1939.

The Bohn Corp.'s license to Aluminum Company lists (R. 2773) the Nelson single strut patents, and it will be noted that the first four of these patents are listed on defendant's blue-print of the narrow strut (R. 2162); of the wide strut (R. 2164), and of the Autothermic (R. 2166), which blue-prints bear dates from 1927 to 1936.

Berry testified positively that the patent situation did deter him commercially. Townhill, who is with Thompson Products, one of Berry's sub-licensees, testified that his company was not making any web type piston, because of a Court decision; Townhill's testimony was before the second decision of this Court in the Piston Case, 31 U. S. 211, on December 9, 1940. The other licensee, Sterling Products, surrendered its license on May 3, 1938 (R. 2820), which was after the first decision of the Court of Appeals in the Piston Case, 92 F. (2d) 330, October 8, 1937, and before the first decision of this Court, 305 U. S. 47, November 7, 1938.

Supreme Court, U. S.
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CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1941.

No. 1141.

OTTO C. BERRY and GENERAL MOTORS CORPORATION,
Petitioners,

v.

BOHN ALUMINUM & BRASS CORPORATION and
ADOLPH L. NELSON.

RESPONDENTS' REPLY TO PETITION FOR CERTIORARI.

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RESPONDENTS' REPLY TO PETITION FOR CERTIORARI.

I.

The statement of facts in the petition is inaccurate in many particulars, and misleading by reason of omissions; but, when all is said and done, this case remains an ordinary patent case, disclosing the common situation in which an early inventor, with a commercially worthless device but with some broad words in his claims, undertakes to blanket the later art, as developed by others into practical form. Against a background where it is conceded[1] that there was only a substitution of known materials with their known respective qualities, the court below has found that there was no new method of operation nor any new result (R. 2890, 2891). This court does not often review such a question.

[1] By plaintiff's expert, as recited in the opinion below (R. 2888, 2890).

II.

Much of the petition and brief refers to the claim that the respondents (defendants below) had made patent pooling contracts with one or both of two strangers to the record,[2] which contracts, it is insinuated, were unlawful. If this argument means anything, it means that *because* a defendant, holding patents upon his infringing devices, has misused these patents, *therefore* the plaintiffs' otherwise invalid patent should be sustained. We believe this court will not wish to spend its time in consideration of such a glaring *non sequitur*; and we feel justified in ignoring this subject matter.[3]

III.

Petitioner would have us understand that the patentability of Berry over the prior art had been repeatedly sustained by numerous tribunals, as enumerated and recited on page 6 of the petition. In fact this patentability never was sustained by any "tribunal," except by the so-called "Law Examiner."[4] Neither the Examiner of Interferences, nor the Board of Appeals, nor the Court of Customs and Patent Appeals, nor the United States District Court at Detroit, nor the Sixth Circuit Court of Appeals had any jurisdiction or power to pass on this question; indeed, by the last-named court any power to

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[2] The Cleveland Trust Company and Aluminum Company of America.

[3] In fact the defendants' Nelson patents never were put into The Cleveland Trust Company "patent pool" referred to by Justice Stone in the cited opinion.

Further, all the evidence of these contracts was finally stricken from the record by the trial judge (R. pp. 1599, 2080); and the defendant below therefore had no need to and did not develop the complete facts on the subject matter.

[4] And he acted under the mistake of fact pointed out in the last substantial paragraph of the opinion of the court below (R. 2891) and in the next paragraph hereof.

pass thereon was most carefully disclaimed (*Cleveland Trust Company v. Berry,* 99 F. (2d) 517). These tribunals passed only upon the question of priority of date of conception as between Berry and the others.

IV.

Over and over again petition and brief assert that the conclusion of the Patent Office (Law Examiner) that Berry was patentable was based upon "substantially the same record" that we have here. The fact is quite otherwise.

The Law Examiner, observing that Berry differed from the earlier Nelson disclosure of steel struts in an aluminum piston only because the Nelson struts were not "imbedded" in the central bosses, and differed from the earlier Ricardo only because Berry made Ricardo's struts of steel instead of aluminum, thought invention was involved because "it was not obvious" how this uniting of struts to bosses and skirts "could be done in a composite structure of different metals." At this time, the only existing "record" on this subject was the Law Examiner's own supposition of fact. So far as he knew, this method of "uniting" was novel—"not obvious"; but this was his fact-blunder. On the present record, it is undisputed that such uniting of different metals ("casting in") was well known in the art. All witnesses agree that the process had long been familiar; and the opinion of the court below (R. pp. 2883-4) recites that this process was old in the art. The whole basis of the Law Examiner's conclusion is therefore non-existent in the present record.

There is a further difference between the present record and that before the Law Examiner. The Hartog earlier patent (R. p. 2429) (earlier in application date) was not before him. This was regarded by the court below as of importance upon the question of patentability (Opinion, R. p. 2890).

V.

We are told (brief pp. 18, 19) that Justice Cardozo's opinion in the *Radio Case*[5] had the effect of making the Patent Office Berry-Nelson interference decision *res judicata* controlling the present controversy. Forty-eight years ago, in *Haughey v. Lee*, 151 U. S., 281-8, this court decided that the defeated party in an interference could nevertheless show, in a later infringement suit brought against him, that the patent issued to a successful opponent was invalid. This was in part in view of the public interest. (See Mr. Justice Jackson's opinion in *Muncie v. Outboard*, March 30, 1942—last main paragraph.) This rule has ever since been the settled law, expressly followed in probably all the circuits, and followed by the court below in earlier cases as well as here (*Root v. Wilett*, 84 F. (2d) 42, 43). This court certainly did not intend in the *Radio Case* to overturn that rule. The question at issue in that case was not patentability, but priority of date as between two men, one of whom was prior to the other in the making of a concededly great invention. The words used by Justice Cardozo must of course be read with reference to the question at issue.

These two issues are completely distinct, both generally and as here arising. One is, *patentability*: Did the advance step over the prior art—*viz.*, uniting the struts with the bosses and the skirt instead of with the skirt only,—constitute patentable invention?—a prior art which included Nelson's earlier patents and publication, as well as Knight, Hartog, etc. The other is, *priority*: If this step did involve invention, which of the two men was earlier?[6]

In the *Radio Case*, Armstrong sought (upon the same record) review of the issue of *priority* once awarded

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[5] *Radio Corp. v. Radio Laboratories*, 293 U. S. 1.

[6] While we do not now contest the Patent Office decision that Berry was entitled to priority over Nelson, yet even as to the specific

by the Patent Office and indeed by the Supreme Court, to De Forest. Here, we sought (upon a new record) review of the Law Examiner's erroneous idea of what was "obvious."

VI.

The petition complains because the court below erroneously said that the trial judge read into the claim "cam grinding," an element not there.[7] It is true that the court below was not verbally accurate in saying that the trial judge read "cam grinding" *into the claims,* if by "claims" we mean the literal measure of infringement, but the court did not mean that. The trial judge did read it *into the invention*[8] as the basis of finding that Berry had made a useful invention. This is a distinction without a difference.

VII.

Claim 35 was held invalid because it did not call for differential materials. The petition says that this should have been "read in." Mr. Justice Stone, in the second *Schriber-Schroth Case* (311 U. S.) did not say that the unnamed element (flexibility) should be read into the claim because it was so much emphasized in the specification. He said that "we may assume" that the patentee was right in that contention in general, but it could not be done in that case because other things in the application history were inconsistent. So here. The patent dis-

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commercially worthless form shown by both in the interference, it should be noted that the Patent Office eventually found that Nelson's conception had an earlier date than Berry's, but awarded priority to Berry on account of the technical rule of diligence in filing the application, while the Canadian Patent Office, having no such technical rule, awarded priority to Nelson.

[7] Though in the next breath it complains because the court *did not* read into claim 35 an element which was not there.

[8] He said (R. pp. 1954-55) "I don't think Berry is any good without cam grinding."

closes Berry's idea that he could have a group of claims depending on this idea of differential materials, and another group of claims depending on structure only. See, for instance, claims 6, 7, 8, 10, 14, 16, 17 and 22. These, as well as 35, are clear attempts to get away from any limitations to differential thermal expansibility.

VIII.

The petition invites comparison with the first *Schriber-Schroth Case* because the subject matter is pistons, and that is so peculiar to the Sixth Circuit. The comparison is fallacious. In that case the patent had been sustained, and plaintiff had no need to, and probably would not, sue in another circuit. In the present case Berry and his exclusive licensee, General Motors Corporation, could find infringement by sellers or users in any district in the United States, and could bring another suit in any one of the other eight circuits. In such further litigation, the General Motors Corporation, the exclusive licensee, would be the party chiefly in interest as to enforcing a monopoly by injunction, and would not be embarrassed by the usual difficulties of the poor inventor.

Many points and inferences or insinuations in the petition and brief invite refutation from the record; but they do not seem to us sufficiently material, upon the question of the allowance of the writ, to justify discussion at this time. So, too, with several reasons, not given by the court below, why its decision was right. In the interest of brevity we do not go further.

We ask that the writ be denied.

Respectfully submitted,

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MAY 14 1942
CHARLES ELMORE CROPLEY
CLERK

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1941.

OTTO C. BERRY and GENERAL MOTORS CORP.,
Petitioners,
vs.
BOHN ALUMINUM & BRASS CORPORATION and ADOLPH L. NELSON,
Respondents.
No. 1141.

PETITIONERS' REPLY TO RESPONDENTS' REPLY TO PETITION FOR CERTIORARI.

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CASES CITED.

Hart Steel Co. v. Railroad Supply Co., 244 U. S. 294.. 5
Haughey v. Lee, 151 U. S. 281..... 4

Morton Salt v. Suppiger Co., ... U. S. ..., 62 S. Ct. 402 3

Radio Corp. v. Radio Lab., 293 U. S. 1..... 4

Smith v. Hall, 301 U. S. 216..... 5
Smith v. Snow, 294 U. S. 1..... 5

U. S. v. Masonite et al. and U. S. v. Univis et al., decided May 11, 1942 3

Statutes Cited.

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Respondents' accusation that the statement of facts in the Petition is "inaccurate" and misleading compels brief reply.

I.

This is not an ordinary patent case, but indeed an unusual patent case, as the facts show.

Calling the Berry piston "a commercially worthless device" comes with bad grace from Respondents. Respondents fought for the very claims in issue, namely, 5, 15 and 18 of the Berry patent. The Nelson patent No. 2,006,008 (R. 24, 38), application for which was involved in the interference with Berry, shows, in Figures 1, 2 and 3, a piston **exactly like Berry's**, and is there asserted to be "a preferred form of the invention" (p. 1, r. c., line 24). The ties 23 shown in the Figure 4 variation are described as simply having the function "to strengthen the connection" between the bosses and the thrust faces. Judge Tuttle called this variation "a good job of hitching" (R. 2115), while the Court of Appeals referred to that variation as "an immaterial difference" (R. 2884) and found infringement of the Berry patent if valid.

The contention that "it is conceded that there was only

a substitution of known materials with their known respective qualities," citing the Court of Appeals' recitation of what plaintiffs' expert Stellmann said, is contrary to the record. The statements quoted by the Court of Appeals are lifted from associated context (R. 81-2), and, thus isolated, create a false impression. Mr. Stellmann not only testified that the Berry structure "was something new in the piston art" in 1922, but that its construction "required more than the skill of the ordinary mechanic" (R. 2045-6). Furthermore, that it has a new mode of operation (R. 2075-6); that the Berry piston can run with a clearance of 0.0015 as distinguished from the then best all-aluminum piston, which required a clearance of 0.0050; that the Berry piston is in "another class" from the all-aluminum piston (R. 1813-4). Stellmann showed that whether the piston be ground round (R. 1804) or oval (R. 2004-6), it can be fitted closer than an all-aluminum piston. All of this testimony was based on practical experience (R. 2033), and was substantiated particularly by the fact that the then best all-aluminum piston was replaced by the Berry type piston in the Franklin air-cooled engine in 1926 (R. 106). None of this testimony was disputed by one skilled in the piston art.

Whatever the fundamental difference between Berry and the art prior, it gave the Berry piston a mode of operation and result which could not be attained by the all-aluminum piston, or by the absurd rings of the Napier, Knight and Hartog patents, or by the Nelson "single strut" piston (Fds. 12, 13, 19, R. 2089-2090, 2092).

II.

The reference to Cleveland Trust and Aluminum Company as "two strangers to the record" is amusing in view of the three-fold tie (agreements digested in the Appendix to the Petition) respecting the "so-called controlled type" (Berry) piston (R. 2665, 2747-8).

Our contention is that **because** Respondents, and those in

consort with them, so doggedly contested Berry's claims in the interference suits, not only resisting Berry, but seeking the same patent themselves, **therefore** the defendants, having had their day in court, should not be permitted to relitigate the question of validity, at least in the absence of newly-discovered non-cumulative evidence. And like any other case where a party seeks to reopen a matter, the Court should apply the maxim,

"He who seeks equity must do equity."

The pooling of patents, cross-licensing with quota restrictions, price fixation, and penalties, constitute unclean hands (Morton Salt v. Suppiger Co., ... U. S. ..., 62 S. Ct. 402; U. S. v. Masonite et al. and U. S. v. Univis et al., decided May 11, 1942).

III.

Respondents are technically correct that the patentability of the claims in issue was "sustained" only by the Law Examiner, although we showed in our Petition (p. 6) that there were three decisions sustaining patentability by the Law Examiner, and that the effort was made to have the Law Examiner reversed before every other Tribunal of the Patent Office, and even by the courts.

In a back-handed way Respondent brought in the Nelson paper (R. 2265) under the guise of relevancy on the question of priority. Thereupon Respondent sought (R. 2248) a recommendation under Patent Office Rule 126,* but were refused.

*"126. The examiner of interferences or the board of appeals may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner."

The contention that the Law Examiner "acted under the mistake of fact," pointed out "by the Court of Appeals" (R. 2891), is also contrary to the record. Of course, the Examiner not only knew about casting aluminum over steel, but specifically he had before him the Nelson paper (R. 2144), on his abortive single strut piston, which paper describes (beneath the illustrations at the bottom of the left column) "a steel strut cast integrally with the slipper portion." What the Law Examiner meant by the expression "not obvious" (R. 2231) was that the combination was not obvious to one skilled in the art, and, therefore, beyond the province of mechanical skill.

IV.

The repetition of the alleged "mistake of fact" by the Law Examiner has been discussed. There is nothing in the record now which is more pertinent on casting than what the Examiner had before him in the Nelson paper.

The Hartog patent was simply cumulative and so classed with the Napier patent (which was before the Law Examiner) by Judge Tuttle (R. 2090). Its cumulative nature and impracticability was substantiated by the testimony of the experienced and practical Stellmann (R. 1855-8), and even by Nelson's own patent, as shown in our Petition (pp. 26-7).

V.

Respondents are mistaken in what they say about Haughey v. Lee, 151 U. S. 281. Examination of the file of the patent there involved reveals that **there was no Interference.** Even if there had been, in so far as that case is in conflict with Mr. Justice Cardozo's unequivocal pronouncement in Radio Corp. v. Radio Lab., 293 U. S. 1, the older case was overruled.

That the Court below has refused, in other cases, to give full effect to the statement of this Court in the Radio Case that

"For the purpose of any controversy between Arm-

> strong and DeForest the validity of the patents must be accepted as a datum"

is more a reason why Certiorari should be granted than why it should not.

The point we make is that Respondents not only contested priority,* but sought and obtained an *inter partes* adjudication of patentability in the Interference proceedings. The adjudication being between the same parties and upon the same character of prior art, the same question cannot be relitigated here.

The situation here is no different from any other case involving *res judicata.* Where questions have once been litigated between the same parties, or their privies, they are bound (Hart Steel Co. v. Railroad Supply Co., 244 U. S. 294). Application of that doctrine here could not prejudice the right of true strangers to the Record to litigate the question of validity de novo (compare Smith v. Snow, 294 U. S. 1, with Smith v. Hall, 301 U. S. 216).

The public interest could not be derogated, but would be better served by permitting Berry to share the benefits of his invention, than by confirming in Respondents and their colleagues the continued domination of the strut piston business.

VI.

Even Respondents' counsel now state, "It is true that the court below was not verbally accurate in saying that the trial judge read 'cam grinding' into the claims," but that "the trial judge did read it into the invention." We showed in our Petition (pp. 21-22) that the trial judge did neither. He could not have done so, when he found the round-ground pistons infringed.†

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*Respondents seek, in footnote 6, to plead that the Patent Office found that Nelson's conception was earlier than Berry's. Of course, it was sought to impress the District Court with this, and much of the evidence was upon the priority phase. However, the "evidence" was so completely exploded on cross-examination that, at the argument (R. 2081), when the Court questioned the Respondents' counsel, "You are not contesting priority?" the answer was "No." In Finding 17 (R. 2091) we find Judge Tuttle doubting the alleged sketch of April 8, 1921, by: "even if in existence at that date."

†The Court of Appeals concurred.

What Judge Tuttle really meant, by his comments anent "cam grinding," was that the Berry piston could be made "real good" (R. 1946) by cam grinding (the manner in which those skilled in the art would make it), while the single strut piston could not be made good. Finally, his conclusion is shown by his Opinion that the Berry structure is "adapted for cam-grinding" (R. 2109); and by his Finding 15 (R. 2091) that the Berry structure "permits cam-grinding, as practiced in the making of pistons before Berry."

VII.

There is nothing whatever in the file history to preclude reading the low expansion capability of the strut, into claim 35. Respondents have pointed out nothing to the contrary.

VIII.

Respondents seek to distinguish the right of an inventor, from that of an adjudicated infringer, to have his case reviewed by this Court. The rights of both are based upon the Constitution. If infringement should arise outside of the Sixth Circuit, Berry is helpless. Berry resides in the Sixth Circuit (R. 1416) and any notice of infringement under R. S. 4900 (35 U. S. C. 49) would provoke a Declaratory Judgment suit with venue laid in the Circuit where the patent stands invalidated. In practical effect, therefore, anyone, anywhere, even General Motors itself, can make and sell Berry's piston without further payment of royalties, unless the judgment of the Court of Appeals is reversed.

We submit that the Writ should be granted.

Respectfully submitted,

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